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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,740	08/17/2001	Klas Eriksson		3790

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EXAMINER

VAN BRAMER, JOHN W

ART UNIT PAPER NUMBER

3622

DATE MAILED: 10/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/913,740

Applicant(s)

ERIKSSON ET AL.

Examiner

John Van Bramer

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3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8/17/2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2001/08/17.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 7 recite the limitation "said display" in lines 10,11, and 12 of claim 1 and lines 10 and 13 of claim 7. There is insufficient antecedent basis for this limitation in the claim. Claims 2-6 are dependent on claim 1 and claims 8-12 are dependent on claim 7, as such, these claims are also indefinite. The examiner suggests changing the term "said display" to read "a display on said monitor".

Claims 7-10 reference numbers enclosed in parentheses which incorporate ambiguities into the claims. Claim 7 line 2 indicates a monitor (7), however claim 7 line 10 indicates display (7). The examiner finds this method of referencing the

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claim ambiguous since Fig. 1 indicates that 7 is a TV. Similar indefiniteness is incorporated into

- a. Claim 7, line 3: ("box (6)"),
- b. Claim 7, lines 4,5,6, and 10: ("means (1)"),
- c. Claim 7, line 8: ("means (2,3,4)"),
- d. Claim 7, line 12 ("means (6)"),
- e. Claim 8, lines 2, 3, and 4 ("means (1)")
- f. Claim 9, lines 3 and 4 ("means (1)")
- g. Claim 10, lines 3-7 ("means 10,11,12", "display (7)" and "means (4,5,6)")
- h. Claim 11 lines 3-10 ("means (1)", "means (6)", and "means (4,5,6)")

The examiner suggests removing all numerical reference enclosed in parenthesis within these claims in order to eliminate the indefiniteness they introduce.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Hendricks et al (U.S. Patent Number: 6,463,585).

Claim 1: Hendricks discloses a method for sending promotional messages in a cable TV network to target groups equipped with a monitor connected to or equipped with a so called set top box, comprising:

- a. Inputting a promotional message (Col 26, lines 14-64).
- b. Selecting a target group (Col 26, lines 14-64).
- c. Attaching information, including the set top box address, to said promotional message (Col 26, lines 14-64).
- d. Sending said promotional message through the network based on said attached information (Col 27, line 63 through Col 28, line 31).
- e. Allocating a portion of said display for said promotional message (Col 74, lines 33-54).
- f. Outputting said promotional message in the allocated portion of said display at the selected target group (Col 28, lines 9-31).

Claim 2: Hendricks discloses a method of claim 1 further comprising the steps of

- a. Definition of a number of time slots (Col 27, lines 16-62).
- b. Allocating said promotional message to a time slot (Col 27, lines 16-62).
- c. Including said timeslot in said information (Col 27, lines 63-67 and Col 28, lines 1-8).

Claim 3: Hendricks discloses a method of claim 1, further comprising the steps of

- a. Identifying non-targeted groups (Col 27, lines 16-62).
- b. Selecting a background promotional message for said non-targeted groups (Col 27, lines 16-62).

Claim 4: Hendricks discloses a method of claim 1 further comprising the steps of

- a. Providing interactions means at said display associated with said promotional message (Col 20, lines 4-35).
- b. Registering any user interactions with said interaction means (Col 20, lines 4-35).

Claim 5: Hendricks discloses a method of claim 1, further comprising the steps of

- a. Selecting a target group (Col 29, line 61 through Col 30, line 4).
- b. Outputting a first promotional message to a first subgroup of said target group (Col 30, lines 49-53).
- c. Outputting a second promotional message to a second subgroup of said target group (Col 30, lines 49-53).
- d. Collecting consumer responses from said first and second subgroups (Col 33, lines 31-32, Col 49, lines 24-45, Col 56 lines 55-59, Col 66 lines 37-66).

Claim 6: Hendricks discloses a method of claim 1, further comprising the steps of

- a. Selecting said target group based upon non-volatile and volatile data (Col 26, lines 14-64).

Claim 7: Hendricks discloses a system for sending promotional messages in a cable TV network to target groups equipped with a monitor connected to or equipped with a so called set top box, characterized by

- a. Means for inputting a promotional message (Col 26, lines 14-64).
- b. Means for selecting a target group (Col 26, lines 14-64).
- c. Means for attaching information, including the set top box address, to said promotional message (Col 26, lines 14-64).
- d. Means for sending said promotional message through the network based on said attached information (Col 27, line 63 through Col 28, line 31).
- e. Means for allocating a portion of said display for said promotional message (Col 74, lines 33-54).
- f. Means for outputting said promotional message in the allocated portion of said display at the selected target group (Col 28, lines 9-31).

Claim 8: Hendricks discloses a system of claim 7 further characterized by

- a. Means for defining a number of time slots (Col 27, lines 16-62).

- b. Means for allocating said promotional message to a time slot (Col 27, lines 16-62).
- c. Means for including said time slot in said information (Col 27, line 63 through Col 28, line 31).

Claim 9: Hendricks et al disclose a system of claim 7, further characterized by

- a. Means for identifying non-targeted groups (Col 27, lines 16-62).
- b. Means for selecting a background promotional message for said non-targeted groups (Col 27, lines 16-62).

Claim 10: Hendricks discloses a system of claim 7, further characterized by

- a. Interaction means at said display associated with said promotional message (Col 20, lines 4-35).
- b. Means for registering any user interaction with said interaction means (Col 20, lines 4-35).

Claim 11: Hendricks discloses a system of claim 7, further characterized by

- a. Means for selecting a target group (Col 29, line 61 through Col 30, line 4).
- b. Means for outputting a first promotional message to a first subgroup of said target group (Col 30, lines 49-53).



- c. Means for outputting a second promotional message to a second subgroup of said target group (Col 30, lines 49-53).
- d. Means for collecting consumer responses from said first and second subgroups respectively (Col 33, lines 31-32, Col 49, lines 24-45, Col 56 lines 55-59, Col 66 lines 37-66).

Claim 12: Hendricks discloses a system of claim 7, further characterized by

- a. Means for selecting said target group based upon non-volatile data and based upon volatile data (Col 26, lines 14-64).

### ***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Freeman ( U.S. Patent Number: 4,602,279) for disclosing an additional method for sending interactive promotional messages to targeted groups. Wachob (U.S. Patent Number: 5,155,591) for disclosing an example of demographically targeted television commercials). Remillard (U.S. Patent Number: 5,561,708) for disclosing a mechanism establishing user interaction with a television medium.

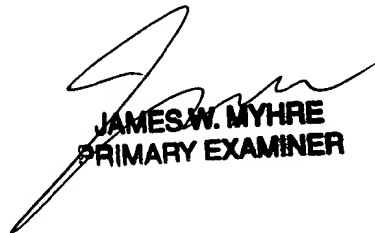
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Van Bramer whose telephone number is (571) 272-8198. The examiner can normally be reached on 9am - 5pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jvb

Date: 10/18/2005

  
**JAMES W. MYHRE**  
**PRIMARY EXAMINER**